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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/448,055	11/23/1999	KIMINOBU KODAMA	990612/LH	4616

7590

04/10/2002

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT

PAPER NUMBER

2167

DATE MAILED: 04/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
09/448,055

Applicant(s)  
Kodama et al

Examiner  
Steven McAllister

Art Unit  
2167



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 11, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-13 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 3/11/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/448,055 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, having a number of different attributes within the range of 10-20; representing a by-product using a set of the values of the attributes of use of the series product; retrieving parts recursively the management process for by-products must be shown or the feature(s) cancelled from the claim(s). No new matter should be entered.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Statutory subject matter must be useful, concrete and tangible. The claimed invention is not concrete because the outcome of the method is in doubt. "Managing the by-product as a product" is not concrete and any number of possible outcomes could occur.

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is indefinite because as written "which are arbitrarily predetermined" could be read to mean "a set of products ... which are arbitrarily determined" or "attributes of use which are arbitrarily determined".

Claim 10 is indefinite because "a manufacturing process" has already been recited.

Claim 10 is indefinite because it is unclear what is meant by "retrieval of parts".

Claim 13 is indefinite because it is unclear what it meant by "managing the by-product as a product".

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Claim 13 is indefinite because “a product” has already been recited in the independent claim. In examining the claim, it was read as “one of said products”.

Claim 13 is indefinite because it recites managing the by-product as one of the products, but as recited in claim 6 all of the products are part of the series product. The by-product, however, is not part of one of the series products.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 13 recites representing the by-product using “a set of the values of said attributes of use”, but those values are the values of the attributes of use of the products of the series product. It was not originally contemplated that the attributes of use were the attributes of use of the series product.

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***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

10. Claims 2- 4, 6, 9, 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Costanza (6189980).

Costanza shows defining a series products defined by attribute (col. 6, lines 56-64) such as size (see Table VIII) and defining a product by values of the attribute (Table VIII). It further shows mapping those attributes to process steps 15,16, deriving a manufacturing process by arranging the process a process 50, and producing the product.

As to claim 3, Costanza shows an attribute of the products of Table VIII including function, since they are all disclosed to be motion transmitting devices (gearboxes).

As to claim 4, Costanza shows having a different size for each product.

As to claim 8, Costanza shows assembly.

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As to claim 12, since the works in progress are inherently produced by the series processes in the overall manufacturing process, the works in progress are automatically manufactured or synthesized by using the manufacturing process of Costanza.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Costanza.

As to claim 5, Costanza shows all elements of the claim except the specific number of attributes being between 10 and 20. However, the number of attributes would vary from item to item depending on the item and its complexity and a product having 10-20 attributes is obvious based on the relative complexity of the item.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Costanza in view of Kristoff et al(6128542).

Costanza shows all elements of the claims except using a manufacturing process derived using a default value. Kristoff et al show use of a default value in deriving a process. It would

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have been obvious to one of ordinary skill in the art to modify the method of Costanza by allowing the use of default values as taught by Kristoff et al in order to allow manufacture of items where certain parameters are not critical.

*Response to Arguments*

14. Applicant's arguments filed 2/27/02 have been fully considered but they are not persuasive.

With respect to the 35 USC 101 rejection of claim 13, the explanation of the grounds for rejection has been expanded on above. A general recitation of "managing" something does not provide for a concrete outcome.

Applicant argues that Costanza does not disclose a series product based on a collection of attributes. The rejection above has been expanded to provide more clarity. As can be seen from Table VIII and the associated text, products are defined by a collection of attributes, for instance, use (gearbox) and size.

Applicant further argues that Costanza does not show definition of a particular product does not occur before derivation of the manufacturing process. However, it is inherent that the item to be produced must be defined before the manufacturing process can be derived.



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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (703) 308-7052.

  
Steven B. McAllister

April 4, 2002